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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/077,667
Filing Date: February 15, 2002
Appellant(s): ENGLMAN, ALLON G.

Daniel J. Burnham
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/17/09 appealing from the Office action mailed 7/21/08 and replacing the Examiner's Answer sent on 08/06/09.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6857958	Osawa	2-2005
5851010	Feinberg	12-1998
6416406	DUHAMEL	7-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-7, 9-15, 17, 25, 31, 33, 35, 37-39, 41, and 43-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osawa (US 6,857,958 B2) and further in view of Feinberg (US 5,851,010).

Regarding claims 1, 25, 43-44, 48 and 51, Osawa teaches a method of conducting a game on a gaming machine comprising: receiving a wager from a player to purchase a play of a basic portion of a game (*see Fig. 9 and the related description thereof*). Osawa teaches in response to the single wager, providing the player with a play of the basic portion of the wagering game including an outcome chosen from a plurality of winning outcomes corresponding to first awards to be awarded to the player wherein the plurality of outcomes include different winning outcomes having corresponding different associated first awards (*see Figs. 1-4 and the related description thereof*). Osawa's gaming machine randomly selects at least one outcome from a plurality of outcomes for a play of the basic portion and rewards the player with the associated award corresponding to the randomly selected outcome (*see col. 11: ln 1-21*). Additionally, Osawa teaches providing an accumulation of a game-play element of the game over a plurality of plays in a series of plays of the basic portion of the wagering game(*see col. 11: ln 47-col. 12: ln 47*). Furthermore, Osawa's accumulation feature provides the player with a second award to a player in response to a predetermined criterion being met, the accumulation feature is reset to include no accumulated game-play elements at the start of a player entering into the game (*see col. 11: ln 47-col. 12: ln 47*). However Osawa is silent with respect to offering a player to purchase a series of plays of a wagering game with a single wager.

In a related gaming patent, Feinberg teaches a method of conducting a wagering game on a gaming machine, which anticipates the idea described as “block wagering” or purchasing a series of plays for a single wager. Feinberg teaches the implementation a wagering game wherein a player places a single wager to purchase a series of plays of a basic portion of a game. Feinberg’s wagering game defines the series of plays as a fixed number of plays of the wagering game (*see col. 2: ln 60-col. 3: ln 35*). Whereas the single wager is being allocated to the entire series of plays is not associated with any specific one of the series of plays but is directed towards giving the player access to play the purchased series of plays (*see col. 3: ln 7-col. 4: ln 67*). Furthermore, Feinberg’s system generates a randomly generated outcome of each play in the series of the plays of the basic portion of the game, at least some of the outcomes providing first awards to the player via the overall result of the series of plays (*ie: whether or not the player has generated more wins or losses*)(*see Fig. 1 and 3 and the related description thereof*). In Feinberg’s teaching, the user selects a wager amount allocated to a series of plays while the single wager is not being associated with any specific one of the series of plays, the single wager being an amount made by any player such that different players pay the same amount and effectively are able to play a plurality of occurrences of the basic game for a single wager (*see col. 2: ln 62-col. 3: ln 35*). Feinberg teaches that one would be motivated to incorporate the wagering system of purchasing a series of plays for a single wager in order to encourage new players to play a wagering game more times and have the ability to assess and ascertain the maximum loss that he/she would have to risk. Therefore one would have been motivated to incorporate the wagering system of Feinberg in order to promote the play of a wagering game at the time the invention was made. Thus it would have been obvious to one of ordinary skill in the

art at the time the invention was made to incorporate the teachings of Feinberg with that of Osawa in order to provide an alternative wagering system that allowed a player to purchase a series of games for a single wager with that of the accumulation game of Osawa.

Regarding claims 2 and 26, Osawa teaches the use of a gaming machine wherein the basic portion is selected from a group consisting of slots, poker, keno, bingo, blackjack, and roulette (*see slot machine [2] of Fig. 1 and the related description thereof*).

Regarding claims 9 and 11, Osawa teaches a method wherein each play includes at least one respective random event that is independent of other plays in the series (*see col. 8: ln 15-35, col. 8: ln 45-62*).

Regarding claims 17 and 41, Osawa teaches a method with a game machine wherein the basic portion includes a slot game having a plurality of symbol-bearing reels that, during each play in the series are spun and stopped to place symbols on the reels in visual associated with a display area (*see slot machine [2] of Fig. 1 and the related description thereof*).

Regarding claims 3-4 and 27-28, Osawa teaches a method wherein the basic portion is triggered by a special outcome in the basic portion and the accumulated element is represented by a position on a trail, ladder, or meter (*see Figs. 6-9 and the related description thereof*).

Regarding claims 5-7, 29-31, and 33, Osawa teaches a method wherein the position identifies a credit amount, a multiplier, a number of free plays of the basic portion, a bonus round, or movement to another position on the trail, the ladder or the meter. Additionally, the accumulated game-play element is a collected object and it further includes the triggering of a bonus in response to collection of a predetermined number of the object during the series of plays (*see Figs. 6-9 and the related description thereof*).

Regarding claims 10 and 12, Osawa teaches a method wherein the game includes the basic portion and a bonus feature triggered by a special outcome in the basic portion, the at least one random event being associated with the basic portion (*see Figs. 6-9 and the related description thereof*).

Regarding claims 13-15 and 37-39, Osawa teaches a method that includes redeeming prior to the completion of the series of plays, the accumulated game-play element for the second award in response to the predetermined criterion in the series of plays being met and after the bonus is complete, returning to the series of plays of the basic portion of the wagering game until completion and the predetermined criterion corresponds to collection of a predetermined number of the accumulated game-play element that corresponds to a certain position of the element on a trail, ladder, or meter (*see Figs. 6-9 and the related description thereof*).

Regarding claim 35, Osawa teaches a game machine wherein each play includes at least one random event that is interdependent of one or more other plays in the series (*see Figs. 6-9 and the related description thereof*).

Regarding claims 45-47, Osawa teaches a game machine wherein the accumulated game-play element is a number of consecutive winning symbol combinations achieved in the basic game, the second award being a credit amount corresponding to the number of consecutive winning symbol combinations. Additionally, the accumulated game-play element is a total value of credits being awarded as the first awards to the player for outcomes achieved in the basic game when a randomly appearing hold-bonus symbol is present during the outcomes that resulted in the first awards in the basic game, the second award being a credit amount related to the total value of credits in the basic game, the second award being a credit amount related to the

total value of credits achieved when the randomly appearing hold-bonus symbol is present during the series of plays (*see Figs. 6-9 and the related description thereof*).

Regarding claims 49-50 and 52, Osawa teaches a method wherein the awarding of the second award occurs in a separate bonus game that is display to the player and the accumulation feature includes a second game-play element that can be accumulated and further including a second game play element during the series of plays of the basic portion of the wagering game and awarding another award to the player in response to another predetermined criterion being met for the second accumulated game-play element (*see Figs. 6-9 and the related description thereof*).

Claims 18 and 42 rejected under 35 U.S.C. 103(a) as being unpatentable over Osawa and Feinberg as applied to claims above, and further in view of Duhamel (US 6,416,406).

With regard to claims 18 and 42, the teachings from Osawa and Feinberg as discussed above are incorporated herein. However, Osawa and Feinberg are silent with regard to teaching the specifics of a draw poker game implementation into the basic game. Duhamel, in an analogous gaming system, teaches, in Figs. 2-9, col. 5: ln 47-67, & col. 6: ln 1-37, a draw poker game and poker hand rankings table. One would have been motivated to combine the teachings of Duhamel with the teachings of Feinberg and Osawa in order to teach the specific implementation of a draw poker game into a basic portion of a game machine in order to diversify the type of games offered and increase the overall excitement of a game machine. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Duhamel with Feinberg and Osawa in order to create a more exciting experience for the player of the game machine.

(10) Response to Argument

-I. Appellant's contends that Osawa Does Not Teach the Claim Elements Related to the "Reset" Feature in the Independent Claims 1, 25, 48, 51.

The prior art of Osawa does in fact teach a "reset" feature. As specified in the teaching of a gaming machine, Osawa teaches a one area clear system and an all areas clear system (*see col. 4: ln 5-28*). Osawa teaches that it is preferable to reset the accumulation feature but maintains that it is upon a predetermined condition. One embodiment is taught in which the predetermined condition is once a prize has been won but is not limited to such an interpretation as contended by the appellant's brief. As exemplified in Osawa, the reset operation may also be manually operated for selecting a reset operation by a player's operation. Such a feature could be used to reset all areas at any point in the game in order to provide a player with a fresh game or to prevent another player from poaching the play of a user (*see col. 10: ln 18-35*). Therefore Osawa does in fact teach a "reset" feature that is adaptable for all circumstances at the discretion of the game design as well as that of the player. Providing a reset before the play of a game when a user has changed is old and well known in the gaming arts and produces the expected result of preventing a subsequent user from unfairly continuing the game play of another. The teachings of Osawa and its adaptable reset system in combination with an obvious matter of Design Choice would have produced the expected result of providing each player with an accumulation independent of those that have previously played the game machine. Therefore it would have been obvious to one of ordinary skill in the art to incorporate the predetermined function of a reset feature at the beginning of a series of plays by a player.

-2. Appellant contends that Osawa contains the “vulturing” problems that Appellant’s sought to avoid with respect to claim 1.

The Examiner respectfully disagrees. Osawa does consider the vulturing effect by incorporating a reset operation at the player’s discretion (*see col. 10: ln 18-35*). By allowing a player to reset the feature at any time of his/her choosing, Osawa not only incorporates the ability to reset at the start of each player’s play, but not be limited by having to reset when a player has remained at the same game machine yet decides to purchase an additional series of play. The assumption provided by the Appellant’s Brief is an unfair characterization of Osawa as it ignores the same situation in which a player who must go to the restroom during a series of play does not prevent the so called “vultures” from taking over the machine once a player leaves. Furthermore, Osawa specifically teaches a manual reset feature that is adaptable to be reset at any point at the discretion of the game designer and the game user.

-3. Appellant Contends that Feinberg and Osawa Teach Away from being properly Combined with respect to Independent Claims 1, 25, 48, 51.

Both Osawa and Feinberg are patents are related towards games of chance. Although the embodiments of the basic game with respect to Feinberg and Osawa are alternative types of games of chance they are both well known in the gaming arts and known as art equivalents at the time the instant invention was made. Furthermore, the use of Osawa teaching a bonus element with respect to a game of chance does not prevent using the wagering method as taught in Feinberg of a well known wagering concept while using an alternative game of chance base game. The teaching of a wagering methods and the implementation of a game method are mutually exclusive aspects in the gaming field. Osawa teaches a slot machine with an

accumulation feature as required by the applicant's claims. Feinberg teaches a different type of game of chance but teaches a wagering system that allows for more players to use a wagering game while providing a method of wagering that eliminates "novice players" from being "quickly fleeced of their money without receiving any entertainment value, often resulting in a lack of repeat customers at casinos" (*see col. 1: ln 15-20*). The application of the betting method taught in Feinberg is to combat the standard problem of one per one play of a game. Instead the system that Feinberg teaches for a player to purchase a series of plays for one wager. By incorporating the feature taught in Feinberg it would not have detracted from the game taught in Osawa since the gaming system already had an accumulation feature of the game that required a series of plays in order to allow a player to win. As a result Feinberg simply teaches an alternative that is well known in the art of collecting the player's money in the beginning so there is an expected amount of games to be played by the player rather than paying for one game at a time. The implementation of the betting method would not destroy the Feinberg teaching as it produces the expected result of providing entertainment value to a player without fleecing them of all of their money quickly (*see col. 1: ln 15-20*). The appellant's representative seems keen on defeating the prior art references by stating that Feinberg describes a 'simple gaming format' as the only reasonable way to incorporate the betting of a series of plays for a single wager. Examiner respectfully disagrees. Even in the described games of "blackjack, roulette, or baccarat, the games themselves still only are provided with one of two outcomes. Either a player wins or loses. The cited sections by the appellant's brief construing the aforementioned games as not being able to be used in conjunction with Feinberg has greatly misconstrued the teaching. The background of the invention simply mentions that the prior art has the basic versions of

those games that exist. Thus the incorporation of Osawa with the teaching of providing the series of plays for one wager as taught in Feinberg would have been obvious to one of ordinary skill in the gaming arts in order to provide an effective method to provide a player to receive entertainment value without the casino quickly fleecing all of their money and therefore providing the expected result of providing a more enjoyable experience for players at the time the invention was made. .

Alternatively, the appellant's brief argues that Osawa teaches away from "monotonous" game formats of Feinberg. The Examiner respectfully disagrees. Both Osawa and Feinberg attempt to augment the experience of the basic games found in the casino arts. Osawa attempts to add an accumulation feature that provides the player with a chance to win a progressive jackpot and therefore a larger prize while Feinberg provides an alternative betting method that provides players with the ability to guarantee a duration or amount of plays of a game based upon an agreed upon wager. Both are features provided to a basic wagering game in order to increase player appeal and the experience for the user while playing a game of chance. At the time the invention was made, the accumulation feature of a gaming machine was taught by Osawa while the method of wagering was provided by Feinberg. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ2d 1509, 1518-19 (BPAI, 2007) (citing *KSR v. Teleflex*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly, Appellant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those

elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396. Accordingly, since the applicant[s] have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

-4. Appellant Contends that the Stated Reasoning for Combining Feinberg with Osawa Lacks "Rational Underpinning" with respect to Independent Claims 1, 25, 48, 51.

The Appellant's representative argues that the combination of Feinberg with that of Osawa lacks "Rational Underpinning" and fails to meet the requirement to establish a proper 103(a) rejection because "no articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" has been established. The appellant's contends that Osawa attempts to increase player interest and that there is an inherent additional coin-input associated with that player interest (*Appeal, pg. 14: ln 10-13*). Additionally, the Appellant argues that the Osawa teaches away from the instant invention because Osawa resets after the accumulated feature reaches a certain threshold. The Examiner respectfully disagrees. Osawa teaches a reset feature that allows the ability for a player or the system administrator to reset the accumulated feature at any time. The statement provided by Osawa is directed towards the operation of the

gaming device when a prize has been provided to the user. Clearly, Osawa would need to reset the accumulation feature after the jackpot was awarded. It is the belief of the Examiner that the appellant's representative is trying to place emphasis on the contradictory observations made by Osawa and that of the instant invention. Osawa teaches that players will be less motivated to play a gaming machine if they must start from a cleared state each time because it lessens the chances in which a player may win the secondary prize (*see col. 4: ln 18-28*), whereas the instant invention states that it performs the reset feature in order to prevent vulturing. The idea of vulturing is well known in the gaming arts and made prevalent in the media and modern culture where a player runs out of his/her money and another player comes in right afterwards to place one coin and wins the jackpot. However, it is the Examiner's contention that Osawa accounts for such a feature by allowing the player to manually reset the accumulation feature at any point of the game therefore it would have been obvious to one of ordinary skill in the art to use the teachings of Osawa in order to teach the state of the art that Osawa was aware while providing protection sort of this type of behavior as is embodied by its ability to "manually select a reset operation by a player's operation" (*see col. 10: ln 18-45*). The appellant further contends that the Osawa is driven by the need for a player to continually enter in credits and coins and that the reset of the accumulation feature "only" occurs when the secondary award has been achieved. Such a characterization is clearly erroneous as the section above clearly shows that Osawa allows a manual reset of the accumulation feature (*see col. 10: ln 18-45*). As such the prior art of Osawa is fully capable of performing the resetting operations argued by the appellant and therefore does not overcome the teachings of the prior art of record.

Furthermore, Appellant's Brief argues that there is no rational underpinning to provide in Osawa the feature of allowing a series of games from the placement of a single wager. Examiner respectfully disagrees. Feinberg teaches the method of placing a single wager to purchase a series of plays. The underlying base game is characterized by a player of "a simple game". The rationalization of applying the methodology of the "alternative wagering system" is to provide convenience to the player in playing the game. The gaming art has constantly been strived to provide different wagering alternatives to users in order to provide a convenience to the end user. A survey of the prior art shows that coin-in operation has subsided into credit wagering and further into tournament play (*ie: another betting method where one wager is made for a series of plays of a game*). The incorporation of Feinberg simply provides a teaching towards the state of the art of a known betting method in the gaming field. Therefore it has been established that, Osawa teaches an accumulation feature in a gaming machine that encompasses the scope of the instant applicant's claims while Feinberg teaches the betting method that is available and well known in the art at the time this invention was made. Therefore the instant combination provides a proper teaching where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing *KSR v. Teleflex*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly, Appellant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or

difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396. Accordingly, since the appellants have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement. In light of the statements made above it is the stated position of the Examiner that the combination of Feinberg with Osawa does provide a rational underpinning that forms a proper rejection under U.S.C. 103(a).

-Appellant contends in that Osawa and Feinberg Fail to Disclose the Claim Elements Related to the “Bonus Game” Associated with the Accumulation Feature in Claim 25 and 51.

Appellant's Brief states that the accumulation feature is: “permitting the player to play a bonus game before completing the series of plays of the basic portion of the wagering game”. Osawa clearly teaches a bonus progressive game where the player accumulates the elements of the basic game and may win the progressive prize when a predetermined number of elements are accumulated. The presentation and interaction with the player of the accumulated symbol provides the feature of playing a bonus game and then returns back to the basic portion of the game. This game be best exemplified by the fact that Osawa clearly distinguishes a second game after the start of basic reel game (*see element ST9-ST13 of Fig. 5 and the related description thereof*). The appellant's brief states that Fig. 5 shows that it is a return to the start of the game at the end of the steps however; the Examiner has never denied that in its current embodiment

Osawa teaches a one wager for one play method. Feinberg has been incorporated to teach the ability for purchasing a series of plays for a single wager as has been described in detail above and has been incorporated herein.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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